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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,300	09/24/2001	Hiroshi Tsuda	826.1752	4780

21171 7590 11/05/2004

STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

JASMIN, LYNDIA C

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/960,300

Applicant(s)

TSUDA ET AL.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18, 19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/24/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 15-17, 20 and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions II and III, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 26, 2004.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9, 14, 18, 19, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolawa et al. (6,370,513 B1).

Kolawa discloses a method for managing merchandise owned by a consumer and embodied in computer readable medium (via keeping of item purchased by a user), including receiving designation of merchandise owned by the consumer through a network (as illustrated in one embodiment a home inventory database that stores an inventory table of ingredient), and managing information relating to the merchandise owned by the consumer based on the designation (see col. 14, lines 1-58; via keeping tracking of the user's inventory). Kolawa further discloses automatically designating

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purchased merchandise as the merchandise owned by consumer (via automatically inserting into the inventory table, each new item ordered), and managing information about purchased merchandise when the consumer purchases the merchandise through the network (such as UPC code for the ingredient, amount available, expiration date).

Kolawa further discloses the concept of receiving designation of unnecessary merchandise through the network (via notifying about discarded product), and releasing designation of merchandise as owned by the consumer for the unnecessary merchandise (via subtracted such items from the inventory table), determining whether or not the consumer has already owned ordered merchandise according to information about the merchandise owned by the consumer when an order for merchandise received from the consumer through the network (inherently recited via keeping track of items purchased by the user), and transmitting a determination result the consumer through the network when it is determined that the consumer has already owned the ordered merchandise (col. 14, lines 44-51).

Kolawa also discloses receiving designation of merchandise not owned but ever used by the consumer through the network (via sampled recommended items), and managing information about merchandise ever used by the consumer (col. 11, lines 53-65), outputting a retrieval result to a terminal of the consumer according to information about merchandise owned by the consumer (for example as illustrated in col. 14. when selecting a recipe for cooking the system will subtract the ingredient list in the user inventory table; for example outputting a list of all the products that are stored in the home inventory database; col. 14, lines 17-51).

Kolawa further discloses the steps of determining merchandise to be recommended according to information about merchandise owned by the consumer (col. 7, lines 51-58), and transmitting information about merchandise to be recommended to the consumer through the network (col. 9, lines 42-50). Also is disclosed the steps of transmitting information about the merchandise to be recommended and also input by another consumer when the recommendation is performed and classifying each piece of merchandise based on an attribute which information indicating a tendency of taste (col. 1, lines 29-44), and determining an attribute matching the taste of the consumer according to information about merchandise owned by the consumer, and transmitting information about merchandise classified into determined attribute to the consumer (col. 2, lines 22-63).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al., in view of Linden et al. (6,266,649). Kolawa disclose all the elements of the claimed invention, but fails to explicitly disclose removing and extracting a piece of merchandise likely to be owned together with another piece merchandise by the consumer who owns the first piece of merchandise.

Linden discloses the concept of recommending items to be purchased based on current contents of a user's shopping cart. Linden further discloses obtaining recommendations that are specific to a designated shopping cart. Linden further discloses the concept of recommending similar product/item that are already used/viewed by a user (for example, if the user is currently searching for books on a particular topic and has added several such books to the shopping cart, this method will more likely produce other books that involve the same or similar topics.

From this teaching of Linden, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the managing system of Kolawa et al. to include the recommendation of item to item similarity taught by Linden et al. in order to help a user in purchasing items based on their specific merchandise record.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spiegel et al discloses the concept of helping customer in


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selecting item based on their popularity. Bowman et al. discloses a search engine, which suggest related terms to a user to allow the user to refine their search.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lynda Jasmin  
Primary Examiner  
Art Unit 3627  
11/11/04

lj